

## REISSUE LITIGATION

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Reissue Application and  
Reexamination (merged proceeding) of ) FOR: PREPARATION AND  
Patentee: RODERICK THOMPSON ) TRANSFER SHEET  
Reissue Serial No.: 09/014,518 ) Patent No. 5,472,790  
Reissue Filed: January 28, 1998 ) Reexamination Control No. 90/004,752  
 ) Reexam Filed: September 17, 1997  
 ) Group Art Unit: 1615

OBJECTION TO PROTEST

BOX 7  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Attention: W. Krynski  
Examiner

Dear Sir:

Patent Owner respectfully objects to the attempted protest dated June 4, 1998 filed by John R. Benefiel, Esq. on the grounds that it neither qualifies under the rules as a protest standing on its own nor qualifies under the rules as a supplement to the protest dated May 26, 1998 that Mr. Benefiel previously filed on behalf of Progressive International Corporation. Patent Owner therefore respectfully requests that the protest not be considered.

[AMDXTHOM98.F10]

The attempted Protestor is impermissibly attempting to participate in the reissue process under the guise of filing protests. The attempted protest dated June 4, 1998 states that it is directed to "new issues raised by Applicant's preliminary amendment," yet relates to a reference already of record in the file of the patent in reissue/reexamination, UK Patent publication GB 224 8 177 A. This attempted protest is no more than new argument relating to a reference already of record. The other documents of which the attempted protestor submits copies, including the parent application of the patent, are similarly of record.

The limited involvement of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.

37 C.F.R. § 1.291 (c).

Protests which will not be entered in the application file include those further submissions in violation of 37 CFR 1.291(c) by which protestor seeks to participate in the examination process. For example, mere arguments relating to an Office action or an applicant's response would not qualify as a new issue. Likewise, additional comments seeking to bring in further or even new data or information with respect to an issue previously raised by protestor would not qualify as a new issue. Even new protests which also argue Office actions or responses or any matter beyond the new issue should not be accepted. Improper protests will be refused consideration and returned by the Examining Group Director. While improper protests will be returned, a new protest by an earlier protestor will be proper and can be entered if it is clearly limited to new issues which could not have been earlier presented. MPEP 1901.07(b).

- 3 -

Serial No. 09/014,518

Because "[m]ere arguments relating to an Office action or an applicant's response would not qualify as a new issue," mere argument relating to Patent Owner's preliminary amendment does not qualify as a new issue. Furthermore, the attempted Protestor could have earlier raised the issue in the Protest dated May 26, 1998.

In view of the foregoing, Patent Owner respectfully requests that the examiner refuse to consider the attempted protest dated June 4, 1998 and any further attempted protests that merely present new arguments based on information already of record. In accordance with MPEP 1901.07(b), this attempted protest should be returned to Mr. Benefiel by the Examining Group Director.

This objection is filed in duplicate for entry in both the reissue and reexamination files.

Respectfully submitted,

Dated: June 10, 1998

By:

  
Lawrence D. Maxwell  
Attorney for Patent Owner  
Registration No. 35,276

BROWN, MARTIN, HALLER & McCLAIN LLP  
1660 Union Street  
San Diego, California 92101

Telephone: (619) 238-0999  
Facsimile: (619) 238-0062  
Docket No.: 5355-RE02

[AMDXTHOM98.F10]

Control No. 90/004,752/Ser. No. 09/014,518

**PROOF OF SERVICE**

I, MARY E. GILLETTE, declare that: I am over the age of eighteen (18) years and not party to the case. I am employed in the County of San Diego, where the mailing occurs; and my business address is the Law Offices of Brown, Martin, Haller & McClain, 1660 Union Street, San Diego, California 92101.

On June 10, 1998 I served the foregoing document described as:

**OBJECTION TO PROTEST**

By U.S. Mail Service I caused each such envelope, with postage thereon fully prepaid, to be placed in the United States Mail at San Diego, California, by placing a copy thereof in a separate envelope for each addressee named hereafter, addressed to each such addressee respectively as follows:

John R. Benefiel, Esq.  
280 Daines Street, Suite 100B  
Birmingham, Michigan 48009-6244

I declare under the penalty of perjury that the above is true and correct and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made. Executed on June 10, 1998, at San Diego, California.

*Mary E. Gillette*  
Mary E. Gillette